

### **REMARKS**

Claims 22-74 are pending in the present application. Claims 22, 23, 25, 27, 33, 60, 63, and 68-70 are rejected. Claims 22, 24, 26, 28-32, 34, 59, 61, 62, 64-67, and 71-73 are objected to.

Claims 22, 24, 26, 28-32, 34, 59, 61, 62, 64-67, and 71-73 have been amended in this response, and new claims 75-78 have been added. No new matter has been added to this application and the new claims are at least supported by the specification.

Applicants have amended claims 24, 26, 28-30, 34, 59, 61, 62, 64-66, and 71-73 to make them independent and to incorporate the subject matter of the independent claims from which they depend. Accordingly, Applicants note that the rejection of claims 24, 26, 28-32, 34, 59, 61, 62, 64-67, and 71-73 is rendered moot. Applicants therefore request allowance of these claims.

#### **Rejection under 35 U.S.C. §102(b)**

Claims 22, 23, 27, 60, 63, and 68 and 70 have been rejected under 35 U.S.C. §102(b) as being anticipated by Johnson (WO 97/04004).

The Office Action asserts that Johnson discloses a compound (compound 26 at page 74), which is encompassed by claim 22 when the substituent variables are as follows: R<sub>1</sub> = H; R<sub>2</sub> = benzoyl; R<sub>3</sub> = H; R<sub>4</sub> = H; R<sub>5</sub> = isopropyl; R<sub>6</sub> = H; R<sub>7</sub> = methyl; R<sub>8</sub> = H; Y = propylene substituted with isobutyl; and Z = -O-CH<sub>2</sub>-CH<sub>3</sub>.

Similarly, the Office Action suggests that claims 22, 23, 25, 33, 60 and 68-70 are anticipated by Falender (Biocatalysts and Biotransformation 13(2); 131-139, 1995. The Office Action suggests that the compound disclosed by Falender, at page 134, is

encompassed by claim 22 wherein the substituent variables are as follows:

R<sub>1</sub> = allylglycine; R<sub>2</sub> = H; R<sub>3</sub> = H; R<sub>4</sub> = H; R<sub>5</sub> = phenyl; R<sub>6</sub> = H; R<sub>7</sub> = benzyl; R<sub>8</sub> = H; Y = butene; and Z = -O-CH<sub>2</sub>-CH<sub>3</sub>.

Applicants respectfully submit that the amendment to claim 22 obviates the anticipation rejections in light of both Johnson and Falender. The amendment to claim 22 limits the definition for R<sub>1</sub> and R<sub>2</sub> wherein "if either 1 of R<sub>1</sub> and R<sub>2</sub> is H, and each of R<sub>3</sub>, R<sub>4</sub>, R<sub>6</sub> and R<sub>8</sub> are H and R<sub>5</sub> is isopropyl or phenyl and R<sub>7</sub> is methyl or benzyl, then whichever of R<sub>1</sub> or R<sub>2</sub> is R or ArR- the definition of R is limited to a saturated or unsaturated moiety having a linear, branched, or non-aromatic cyclic skeleton containing one to ten carbon atoms, zero to four nitrogen atoms and zero to four sulphur atoms, and the carbon atoms are optionally substituted with: =S, -OH, -OR<sub>10</sub>, -O<sub>2</sub>CR<sub>10</sub>, -SH, -SR<sub>10</sub>, -SOCR<sub>10</sub>, -NH<sub>2</sub>, -NHR<sub>10</sub>, -N(R<sub>10</sub>)<sub>2</sub>, -NHCOR<sub>10</sub>, -NR<sub>10</sub>COR<sub>10</sub>, -I, -Br, -Cl, -F, -CN, -CO<sub>2</sub>H, -CO<sub>2</sub>R<sub>10</sub>, -CHO, -COR<sub>10</sub>, -CONH<sub>2</sub>, -CONHR<sub>10</sub>, -CON(R<sub>10</sub>)<sub>2</sub>, -COSH, -COSR<sub>10</sub>, -NO<sub>2</sub>, -SO<sub>3</sub>H, -SOR<sub>10</sub>, -SO<sub>2</sub>R<sub>10</sub>, wherein R<sub>10</sub> is a linear, branched or cyclic, one to ten carbon saturated or unsaturated alkyl group".

Support for this amendment is found in at least the claims as originally filed and at page 2, lines 24-34 of the specification as filed. The amended claim 22 removes the possibility of R<sub>2</sub> or R<sub>1</sub> from being either a benzoyl or allylglycine moiety when the substituents at R<sub>3</sub>-R<sub>9</sub> are limited to the substituents taught by both Johnson and Falender. Accordingly, Applicants respectfully request the rejections under 35 U.S.C. §102 as they relate to the Johnson and Falender references be removed. Furthermore, due to the amendment of claim 22, the dependent claims thereof are also not anticipated for at least

the same reason. Accordingly, Applicants respectfully request that the rejections to claims 22, 23, 25, 27, 33, 60 and 68-70 be removed.

New claims 75-78 are intermediate to the existing claim 22 and the subsequent dependent claims. Support for the new claims is found in at least the specification and the claims currently on file. These amendments merely limit the substitutions possible at  $R_1$  through  $R_9$ , and accordingly, add no new matter. Specifically, support for new claim 75 comes from at least claim 22 wherein the limitations to  $R_1$ - $R_9$  are a subset of those defined by claim 22. Support for new claim 76, comes from at least claim 22 and specifically support for the amended definition of  $R_1$  and  $R_2$  comes from at least claim 35, for the amended definition of  $R_3$  and  $R_4$  comes from at least claims 31 and 41, for the amended definition of  $R_6$  comes from at least claim 46 and for the amended definition of  $R_8$  comes from at least claim 47. Similarly, support for new claims 77 and 78 comes from at least 70 and 68, respectively.

### **Conclusion**

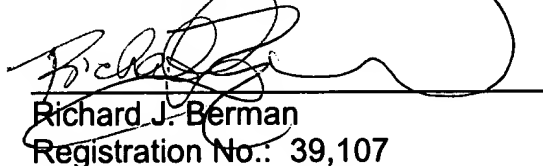
In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, rejoinder of claim 74, allowance of claims 22-78 and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing docket number 108281-00000.

Respectfully submitted,

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